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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/773,669

02/06/2004

Steffen Dubnack

GK-ZEI-3226/500343.20238

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01/04/2008

REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

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EXAMINER

APANUS, MICHAEL

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

01/04/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/773,669

Applicant(s)

DUBNACK ET AL.

Examiner

Michael Apanius

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The amendments to claims 1 and 3 and the replacement abstract are acknowledged. It is noted that the replacement abstract does not show the amendments made. It also appears that claim 3 should have been labeled "Currently Amended" due to the change in line 4 of the claim. However, in order to expedite prosecution, the non-compliant amendment has been entered.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are generally indefinite. Some particular examples are listed below. However, the list may not be exhaustive.

4. At claim 1, line 3, the scope of "a diseased change" is unclear. At claim 1, lines 6-7, "the latter" should be replaced by specific language referring to the intended element. The meaning and scope of "tissue selection" and "selecting ... any pathologically changed tissue" is unclear in the context of the claims. At claim 1, lines 10-14, it is unclear if the wherein clause is defining further steps or is defining when "selecting" and/or "removing" (line 10) is carried out. At claim 3, line 4, the relationship

of "and/or" to the claim limitations is unclear. Claim 3 does not particularly point out which limitations are in the alternative.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Eggers et al. (US 5,630,426). Eggers discloses a method for tissue-selective treatment in surgery comprising the steps of:

positioning a probe (20) in an area of a diseased change after placing on a body organ or body tissue to be treated (column 5, lines 41-50);

activating tissue selection in that different electrical and/or electromagnetic stimulus signals which can be preadjusted or modulated are sent to the tissue in order to stimulate the latter (column 5, lines 51-60);

distinguishing the healthy tissue parts from pathologically changed tissue parts by evaluating responses to the stimuli (column 6, lines 46-49); and

selecting any pathologically changed tissue for treatment;

wherein, in the case of healthy tissue, the probe is repositioned and tissue selection is reactivated, and in the case where pathologically altered tissue is identified, treatment is carried out (paragraph bridging columns 10 and 11).

7. In regards to claim 2, the stimulus response is carried out by iterative transmission of stimulus signals (paragraph bridging columns 10 and 11).
8. In regards to claim 3, a direct online tissue selection is carried out by alternating treatment and positioning with tissue selection and immediate evaluation of the stimulus responses (paragraph bridging columns 10 and 11) and the user is warned during treatment of critical tissue regions (via display 45).

### ***Response to Arguments***

9. Applicant's arguments filed 10/23/2007 have been fully considered but they are not persuasive.
10. Applicant argues that no stimulation is carried out in Eggers for tissue selection. In response, Eggers discloses applying a low voltage radio-frequency current to the targeted tissue mass (column 5, lines 51-60). The measured response of the tissue to the low voltage radio-frequency current (column 6, lines 28-29) is defined by the electrical characteristics of the tissue.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Apanius whose telephone number is (571) 272-5537. The examiner can normally be reached on Mon-Fri 8am-4:30pm.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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